

REMARKS

In the Final Office Action (“FOA”) dated December 29, 2005, the Examiner rejected claims 1-10.

I. Rejection of Claims 1-10 under 35 U.S.C. § 103

The Examiner maintains the rejection of claims 1-10 under 35 U.S.C. § 103 as allegedly being unpatentable over Glaze, et al. (U.S. Patent No. 5,593,888) in view of “Gardening Series Basics Choosing a Soil Amendment.” FOA at 2. The Examiner cites Glaze as allegedly teaching “the method of purifying contaminated soil comprising adding a soil improving material (unspecified “other amendments” column 15, line 40); and mixing the soil by agitation while adding microbes.” *Id.* The Examiner cites “Gardening Series” as allegedly teaching “that it is advantageous to add perlite to clay soils to improve their permeability,” and states that “Applicant’s specification teaches that perlite inherently meets the claimed properties.” *Id.* Further, the Examiner states that “[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the Glaze process to have included perlite as the ‘other amendment’, in order to improve soil permeability, for example; thus resulting in the claimed properties called for in claim 1.” FOA at 3.

II. Remarks

Applicants respectfully continue to traverse because the Examiner has not set forth a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, the cited references must teach or suggest all the claim limitations. M.P.E.P. § 2142-43 at 2100-128 – 2100-132. Moreover, “obviousness cannot be predicated on what is not known at the time an invention is made, even if the inherency of a feature is later established.” M.P.E.P. § 2141.02 at 2100-126. Indeed, the Federal

Circuit reversed a decision of the Board of Patent Appeals because the feature relied on to demonstrate obviousness was not known in the prior art, stating, “[o]bviousness cannot be predicated on what is unknown.” *In re Rijckaert*, 9 F.2d 1531, 1534 (Fed. Cir. 1993); *see also In re Napier*, 55 F.3d 610, 613 (Fed. Cir. 1995) (affirming a § 103 rejection based in part on inherent disclosure in one of the references where feature *was known* at the time the invention was made).

The Examiner asserts that perlite inherently meets claim limitations because it was known to add perlite to soil to improve soil permeability. To support the reliance on inherency in a § 103 context, the Examiner cites to M.P.E.P. § 2112 and two cases - *In re Best* and *Schering v. Geneva* - for the proposition that “the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable.” FOA at 5. Upon closer examination, however, both cases on which the Examiner relies discuss inherency in the context of § 102. *See In re Best*, 562 F.2d 1252, 1254 (CCPA 1977) (applying inherency under § 102, and stating, “our analysis of the comparative data offered by appellants convinces us that the burden of rebutting the PTO’s reasonable assertion of inherency under 35 U.S.C. § 102, or of prima facie obviousness under 35 U.S.C. § 103, has not been met); *see also Schering v. Geneva*, 339 F.3d 1373, 1377-78 (Fed. Cir. 2003) (applying an inherency principle in the context of anticipation under 35 U.S.C. § 102(a)). Thus, the applicable principle from the Federal Circuit caselaw is that “[o]bviousness cannot be predicated on what is unknown.” *See Rijckaert*, 9 F.2d at 1534.

At the time the invention was made, there is no indication that it was known that perlite had non-swelling and non-viscosity properties, and thus perlite can not inherently provide the claimed properties. Therefore, the Examiner has not established a *prima facie* case of

obviousness because the combination of Glaze and "Gardening Series" does not teach or suggest all the claim limitations - *i.e.* use of a soil-improving material that was known to be water-absorbing and to have non-swelling and non-viscosity properties. M.P.E.P. § 2142-43 at 2100-128-2100-132; *In re Rijckaert*, 9 F.2d at 1534.

Thus, because the Examiner has failed to establish a *prima facie* case of obviousness, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 1-10 under 35 U.S.C. § 103(a).

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request reconsideration of the application and the timely allowance of the pending claims. If the Examiner does not find the claims allowable, the undersigned requests that, prior to taking action, the Examiner call her at (650) 849-6611 to set up an interview.

Please grant any further extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: April 25, 2006

By: Elisabeth Barek
Elisabeth Jaffe Barek
Reg. No. 46,797